

Appl. No.: 10/720,023  
Amdt. dated 03/24/2008  
Reply to Office Action of December 13, 2007

### **REMARKS/ARGUMENTS**

This is a full and timely response to the final Office Action dated December 13, 2008. A petition for a one month extension is filed herewith extending the response deadline to April 13, 2008.

Applicant notes with appreciation the Examiner's thorough examination of the application as evidenced by the Office Action.

#### **I. Request for Telephonic Interview**

As noted above, applicant's undersigned attorney requests a telephonic interview with the Examiner, should there be any questions about this amendment, or if any of the claims are not considered in condition for allowance.

#### **II. Summary of Claim Status**

Prior to the issuance of the present Office Action, Claims 5-16 were pending.

Applicant amended some of Claims 5-16, and has added New Claims 17-19.

It is respectfully submitted that the resulting pending 5-19 are patentable. As such, Applicant respectfully requests reconsideration and allowance of the present claims in light of the following remarks.

#### **III. Claims Previously Indicated as Allowable – Claims 5-10 and 12-16**

Of the Claim 5-16 reviewed in the last Office Action, Claims 5-10 and 12-16 were previously indicated as allowable. The Applicant appreciates such a review by the Examiner.

It may nevertheless be noted that the applicant's undersigned attorney has made minor amendments to some of these claims for clarity. These amendments will be addressed in order of the amended claims.

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*Claim 5*

Claim 5 has been amended for clarity. As may be seen, the requirement of a “flexing” motion in the preamble has been added for clarity, as has the requirement later in the claim that the elbow joint be “flexed”. It is respectfully submitted that this claim is still clearly patentable.

*Claim 10*

The preamble of Claim 10 has been amended for clarity so as to provide antecedent basis for the term “forearm” later in the claim.

**IV. Claim 11 – Currently Rejected on Art**

The examiner set forth the following in issuing a Section 102 rejection in the December 13, 2007 Office Action:

**Claim 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Mann US 5,514,081.**

**As to claim 11, Mann discloses an orthotic device for manipulating a user's limb comprising a structural body portion (76), an inflatable member (34), a retention member (straps 92 and 94), interconnecting said structural body portion and said inflatable member such that a portion of the limb can be inserted between the body portion and inflatable member and wherein a gap is present (18) between said limb portion and said structural body portion (fig. 8), and an inflating device (58) for inflating the inflatable member such that the member tends increase tension in said retention member such that said limb is urged towards the structural body portion wherein said gap is reduced to result in extension of the limb. The fact that the gap is reduced is an intended use limitation and does not provide any further structure to the device the gap is fully capable of performing the function. The gap will naturally widen and reduce based upon arm flexion or extension. Furthermore It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.**

Applicant has not been able to locate the gap 18 referenced above, and thus cannot fully comprehend the rejection depending upon this language. Applicant attempted to reach the Examiner at least twice in order to discuss the matter via telephone but did not have his messages returned with a call to his knowledge.

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Nevertheless, applicant has endeavored to amend the claim for clarity, and respectfully requests reconsideration of the rejection set forth by the Examiner. It may be noted that the applicant has deleted the "can be inserted" language, and replaced it with more positive claim limitations in that a portion of the limb is now "**positioned**" at a certain location "**when said device is attached to said limb and said inflatable member is in said lesser inflated mode**".

Applicant would also like to note that an amendment has been made requiring that the "**limb moves relative to said retention member**" during the inflation process. This language will be recognized as in at least some of the claims in the issued parent application. A terminal disclaimer has been filed in relation to this parent application.

While on the subject, Applicant would like to note that new Claim 18 depends upon Claim 11.

**V. New Claims**

New Claim 17 is dependent upon (Allowed) Claim 5.

New Claim 18 is dependent upon Claim 11 as amended.

New Claim 19 is added in order to clarify coverage previously issued in the parent application as USPATNO 6,669,660, which has been associated via terminal disclaimer. Although a new claim would not include underlining and deletion, the changes to issued Claim 18 in USPATNO 6,669,660 are shown below as if amendment were made:

**19.** An orthotic device for attachment to an arm of a user, said arm having an elbow joint between a forearm and an upper arm, said arm when straight being generally elongate with a first side and a second side, each of said two sides each extending the length of said arm, said device comprising:

a substantially rigid structural **body frame** portion for contacting said arm at a first location being on said first side of said arm in the vicinity of the elbow;

an upper arm contacting portion for contacting said upper arm on said second side of said arm, said upper arm contacting portion being attached relative to said body portion;

an inflatable member for contacting said forearm on said second side of said arm;

at least one strap for attaching said inflatable member relative to said substantially rigid body portion, such that a portion of said forearm is positioned intermediate said substantially rigid body portion and said inflatable member, with a gap being present between said forearm portion and said substantially rigid body portion; and

an inflation device for inflating said inflatable member such that said elbow joint tends to be straightened as said forearm pivots relative to and towards said substantially rigid body portion and said gap is at least partially closed.

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This should not be construed as an admission that the issued Claim 18 is not suitably clear in scope, but it is submitted that the above claim provides additional clarity.

### **Conclusion**

This is a full and timely response to the final Office Action dated December 13, 2007. A petition for a one month extension is filed herewith extending the response deadline to April 13, 2008.

The foregoing amendments to certain of the claims, when taken in conjunction with the appended remarks, are believed to have placed the present application in condition for allowance, and such action is respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

/Gregory T. Gronholm/

Gregory T. Gronholm  
Registration No. 32,145

**Customer No. 00826**  
**ALSTON & BIRD LLP**  
Bank of America Plaza  
101 South Tryon Street,  
Suite 4000  
Charlotte, NC 28280-4000  
Tel Atlanta Office (404) 881-7000  
Fax Atlanta Office (404) 881-7777

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